APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,690	10/20/2000	Kia Silverbrook	NPA064US	8647

24011	7590	07/28/2006

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EXAMINER
PORTER, RACHEL L

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 May 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,8-31 and 34-44* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,8-31, and 34-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the Applicant's response filed 5/1/06.

Claims 1-5,8-31, and 34-44 are pending.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claims 1-5 and 8-26 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

4.   Claim 1 recites " [a] method of providing insurance services via a form having

printed thereon information related an insurance service and a plurality of tags, each tag

containing coded data indicative of an identity of form and its own location on the

form..." in lines 5-6. There is insufficient antecedent basis for this limitation (the word

"its") in the claim. It is unclear what is being reference with this term. (an identity, the

tags, etc.)

Claims 1-5, and 8-26 inherit the deficiencies of claim 1 through dependency and

are therefore also rejected.

It is noted that claims 1, 4 and 5 have been amended. However, these

amendments do not overcome the 112, 2nd rejections previously set forth. The steps/

functions performed in method and by the sensing device remain unclear to the

Examiner. For example, in claim 1, the second step is somewhat narrative and does

not clearly outline what steps are being performed. While reading claim 1, it would

appear that only 3 steps are performed: 1) printing a form containing information relating

to an insurance service; 2) receiving in a computer system indicating data from a

sensing device regarding the identity of the form and a position of the sensing device

relative to the form; and 3) identifying, in the computer system and from the indicating

data, at least one parameter relating to insurance.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-5,8-31, and 34-44 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Montagna et al (USPN 4,899,292) and in view of Luchs (USPN

4,831,526).

As per claims 1-5 and 8-26, Montagna teaches a method for using a computer

system including a sensing device to receive and input information onto a form

containing a plurality of tags. (col. 5, lines 22-36; Figure 2 (ref. 41); col. 8, lines 1-6).

The tags (which may be part of a hyper page) allow information to be placed in a

particular location on the form. Moreover, the touch screen feature of the system (col. 8, lines 8-46), allows the sensing device to input data in the encoded sections of the forms relative to the location tags.

Montagna further discloses a system and method wherein the position of the sensing device relative to physical media/document is record (xy coordinates) and stored within the computer system (Figure 11, (col. 11, lines 27-44)

Montagna discloses further discloses capturing information related to the field of insurance, but does not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a method wherein forms relating to insurance services are generated. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses a method in which customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8).   At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Montagna with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

As per claims 27-31, and 34-44, Montagna teaches a computer system including a sensing device to receive and input information onto a form containing a plurality of tags. (col. 5, lines 22-36; Figure 2 (ref. 41); col. 8, lines 1-6). The tags (which may be part of a hyper page) allow information to be placed in a particular location on the form. Moreover, the touch screen feature of the system (col. 8, lines 8-46), allows the sensing device to input data in the encoded sections of the forms relative to the location tags.

Montagna further discloses a system and method wherein the position of the sensing device relative to physical media/document is record (xy coordinates) and stored within the computer system (Figure 11, (col. 11, lines 27-44)

Montagna discloses further discloses capturing information related to the field of insurance, but does not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a method wherein forms relating to insurance services are generated. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses a method in which customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8).   At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Montagna with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which

properly positions information on regarding various insurance services into the

appropriate forms, thereby minimizing the need for repetitive entry of insurance data for

each insurance application (See Luchs: col. 2, lines 6-18) and producing documents

that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

Response to Arguments

7.   Applicant's arguments with respect to claims 1-5,8-31, and 34-44 have been

considered but are moot in view of the new ground(s) of rejection.

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
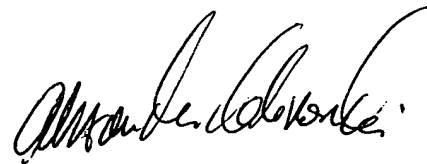
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RP

ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER